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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,203	12/26/2001	James Richard O'Brien	170933-1	1395

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EXAMINER

GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,203

Applicant(s)

O'BRIEN, JAMES RICHARD

Examiner

Ernesto Garcia

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 1-3 and 12 are objected to because of the following informalities:
regarding claim 1, the limitation --the-- should be inserted before "fasteners" in lines 10 and 11, and the limitation "ground" in line 18 should be --terrain--;
regarding claims 1-3, --panel-- is missing after "fence" in line 1 of each claim; and
regarding claim 12, the limitation "the respective rail" in lines 8 and 11 makes unclear whether the rail is the first rail, the second rail, or both rails. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-9 and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hinkle, 3,456,921 (see marked-up attachment).

Regarding claim 1, Hinkle discloses in Figures 1 and 3 a fence panel comprising a first rail **23**, a second rail **26**, spaced-apart pickets **17**, and fasteners **28-31**. The first rail **23** is disposed parallel and spaced-apart from the second rail **26**. The first rail **23** and the second rail **26** define a longitudinal length of the fence panel, an opposing first side edge **15,16** and an opposing second side edge **22,25**. The first rail **23** and the second rail **26** are disposed at an angle relative to horizontal.

The pickets **17** define a pair of opposing outer pickets **A7** and inner pickets **A8**, and the pickets **17** are disposed substantially perpendicular to horizontal (see marked-up attachment). The pickets **17** are attached to the first rail **23** and the second rail **26** with the fasteners **28-31**. The inner pickets **A8** are respectively attached to the first rail **23** and the second rail **26** by the fasteners **28-31** on the first side edge **15,16**. The outer pickets **A7** are respectively attached to the first rail **23** and the second rail **26** by the fasteners **28-31** on the second side edge **22,25**. Applicant is reminded that the fence panel is racked, and conforms to a slope of the rails substantially to a slope of a portion of a terrain surface. Furthermore, applicant is reminded that the method of racking the fence panel and conforming the fence panel to a slope of the terrain surface is not germane to the issue of patentability of the fence panel itself. Therefore, this limitation has been given limited patentable weight. See MPEP ' 2113. Applicant is reminded that the fence panel of Hinkle is able to be racked by moving opposing ends of the panel in opposing directions transverse to the longitudinal axis of the rails, and the fence panel of Hinkle is able to conform the rails to the terrain surface by changing the

angle between the pickets and the rails while the pickets remain substantially perpendicular to the horizontal without the first rail and the second rail rolling away from the inner pickets and the outer pickets.

Regarding claims 2 and 13, the fasteners **28-31** comprise flexible mild steel welds (col. 3, lines 4-6).

Regarding claim 3, the fence panel further comprises a pair of end posts **12** attached to opposing ends of the first rail **23** and the second rail **26**.

Regarding claims 5, 7, 9 and 15, applicant is reminded that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Furthermore, applicant is reminded that the fence panel is able to be selectively racked during installation between about 0 degree and 20 degrees relative to the angle at which the rails are disposed when the rails and the pickets are initially attached together.

Regarding claims 6 and 14, an angle at which the first rail **23** and the second rail **26** are disposed is between about 0 degrees and 60 degrees.

Regarding claim 8, an angle at which the first rail **23** and the second rail **26** is selected from a group comprising 0 degree, 20 degrees, 40 degrees and 60 degrees.

Regarding claim 12, Hinkle discloses, in Figures 1, 3 (see marked-up attachment) and 4, a fence panel comprising a pair of rails **23,26**, inner pickets **A8**, a pair of outer pickets **A7**, and fasteners **28-31**.

The rails **23,26** are disposed parallel and spaced-apart relation and at an angle relative to horizontal. The rails **23,26** each define an opposing first side edge **15,16** and an opposing second side edge **22,25**. The rails **23,26** comprise a first rail **23** and a second rail **26**.

The inner pickets **A8** and the outer pickets **A7** are attached to the first rail **23** and the second rail **26** by the fasteners **28-31**. The inner pickets **A8** are respectively attached to the first rail **23** on the first side edge **15,16**. The outer pickets **A7** are respectively attached to the second rail **26** on the second side edge **22,25**.

Applicant is reminded that the fence panel is racked, and conforms to a slope of the rails substantially to a slope of a portion of a terrain surface. Furthermore, applicant is reminded that the method of racking the fence panel and conforming the fence panel to a slope of the terrain surface is not germane to the issue of patentability of the fence panel itself. Therefore, this limitation has been given limited patentable weight. See MPEP ' 2113. Applicant is reminded that the fence panel of Hinkle is able to be racked by moving opposing ends of the panel in opposing directions transverse to the

longitudinal axis of the rails, and the fence panel of Hinkle is able to conform the rails to the terrain surface by changing the angle between the pickets and the rails while the pickets remain substantially perpendicular to the horizontal without the first rail and the second rail rolling away from the inner pickets and the outer pickets.

Regarding claim 16, the fence panel further comprises a pair of end posts **12** attached to opposing ends of the rails **23,26**.

Regarding claim 19, Hinkle discloses a method of making a fence section. The method comprises:

a) dispose a pair of rails **23,26** parallel and spaced-apart at an angle to a horizontal plane; the rails define opposing first side edge **15,16** and opposing second side edge **22,25**;

b) attach inner pickets **A8** to a respective one of the rails **23,26** substantially perpendicular to the horizontal plane with fasteners **28-31** such that the fasteners **28-31** are between the inner pickets **A8** and the first side edge **15,16** of the respective one rail;

c) attach a pair of opposing outer pickets **A7** at opposing ends of the respective rail substantially perpendicular to the horizontal plane by fasteners **28-31** between the outer pickets **A7** and the second side edge **22,25** of the respective rail; and

repeat steps b) and c) for the other rail of the pair of rails **23,26**;

the fence panel is racked, and conformed to a slope of the rails substantially to a slope of a portion of a terrain surface. Applicant is reminded that the fence panel of

Hinkle is able to be racked by moving opposing ends of the panel in opposing directions transverse to the longitudinal axis of the rails, and the fence panel of Hinkle is able to conform the rails to the terrain surface by changing the angle between the pickets and the rails while the pickets remain substantially perpendicular to the horizontal without the first rail and the second rail rolling away from the inner pickets and the outer pickets.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinkle, 3,456,921 (see marked-up attachment) in view of Dye, 5,544,866.

Regarding claims 4, 11 and 17, the fence panel further comprises angle members **32** having a first leg **A12** and a second leg **A13**. The first leg **A12** of each of the angle members **32** is attached to a distal end of the first rail **23** or the second rail **26**. However, Hinkle fails to disclose the second leg **A13** defining a pair of holes and the fence panel further including screws extending through the holes. Dye teaches in Figures 2 and 3 a second leg **30** defining a pair of holes **26** and screws **18,20** to

connect rails to posts. Therefore, as taught by Dye, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a pair of holes and screws to connect the rails to the posts.

Claims 1, 10, 12-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (see marked-up attachment provided in last office action) in view of Costacurta, FR-1,061,340.

Regarding claims 1 and 12, Figure 6 of applicant's figure disclose a fence panel comprising a first rail **A1**, a second rail **A2**, spaced-apart pickets **A6**, and fasteners **A9**.

The first rail **A1** is disposed parallel and spaced-apart from the second rail **A2**. The first rail **A1** and the second rail **A2** define a longitudinal length of the fence panel, an opposing first side edge **A3** and an opposing second side edge **A4**. The first rail **A1** and the second rail **A2** are disposed at an angle relative to horizontal.

The pickets **A6** define a pair of opposing outer pickets **A7** and inner pickets **A8**, and are disposed substantially perpendicular to horizontal. The inner pickets **A8** and the outer pickets **A7** are attached to the first rail **A1** and the second rail **A2**.

The fasteners **A9** are between the inner pickets **A8** and the first side edge **A3** of the first rail **A1** and between the inner pickets **A8** and the second side edge **A4** of the second rail **A2**.

However, the prior art fails to disclose the fasteners **A9** between the outer pickets **A7** and the second side edge **A4** of the first rail **A1** and between the outer pickets **A7**

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and the first side edge **15,16** of the second rail **26**. The French patent '340 teaches fasteners between the outer pickets **C** and a second side edge of a first rail **A** and between a first side edge of a second rail to fasten the outer pickets to the rails at intersections. Therefore, as taught by the French patent, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include fasteners between the outer pickets and the second side edge of a first rail and the first side edge of the second rail to fasten the pickets to the rails.

Regarding claims 10 and 18, Figure 6 of applicant's figures shows the first rail **A1** and the second rail **A2** are four-wall tubular members.

Regarding claim 13, the fasteners **A9** comprise flexible mild steel welds.

Regarding claim 14, an angle at which the first rail **A1** and the second rail **A2** are disposed is between about 0 degrees and 60 degrees.

Regarding claim 15, applicant is reminded that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Furthermore, applicant is reminded that the fence panel is able to be selectively racked during installation

between about 0 degree and 20 degrees relative to the angle at which the rails are disposed when the rails and the pickets are initially attached together.

Regarding claim 16, the examiner takes Official Notice that fence panels are often attached between posts (see Coltrin, 4,074,893). Therefore the fence panel further comprises a pair of end posts attached to opposing ends of the first rail **A1** and the second rail **A2**.

Response to Arguments

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Applicant has merely discussed and defined "rolling" as being an effect. Despite showing rolling in a diagram, this effect does not differentiate over the prior art as the prior art is capable of not producing rolling. Furthermore, applicant is reminded that structural limitations will probably define over the prior art instead of an effect limitation.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Coltrin shows a fastener that runs around the intersection of the rail and the pickets. Rosenbaum teaches a similar fence panel. Furthermore, it would have been obvious to include the improvement of Hinkle in Nunez fence panel.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.


Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3600

E.G.

December 8, 2003

Attachment: one marked-up copy of Hinkle, 3,456,921 showing Figure 3 corresponding to cross-sections of Figure 1.

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PN. 3,456,921

